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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,844	03/16/2001	Ning Shen	9548.51US01	7076
23552	7590	02/15/2005	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			DADA, BEEMNET W	
			ART UNIT	PAPER NUMBER
			2135	
DATE MAILED: 02/15/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/810,844

Applicant(s)

SHEN, NING

Examiner

Beemnet W Dada

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-13 and 15-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-13 and 15-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This office action is in reply to an amendment filed on November 23, 2004. Claims 3-8 have been amended, claims 1, 2 and 14 have been cancelled and new claims 15-18 are added. Claims 3-13 and 15-18 are pending.

### ***Response to Arguments***

2. Applicant's arguments filed November 23, 2004 have been fully considered but they are not persuasive. Applicant argues that Brown does not suggest that the access controller (12) is used to control the connection between the hard disk body and the power supply interface. Applicant further argues that claim 3 requires that the hard disk body and power supply interface are internal to the hard disk (also see figure 1). Examiner respectfully disagrees.

Holehan discloses a hard disk comprising a hard disk body and a hard disk control device which is used to receive said control signal issued by said control interface of said fingerprint identifier to control the operation state of said hard disk body [column 5, lines 24-33 and figure 3, units 42, 48 and 50]. Furthermore, Brown discloses a data security device for controlling access including connecting a power supply, an electronic controlled switch, hard disk and an access control interface [column 2, lines 8-23 figures 1-4]. Therefore, the examiner asserts that the combination of Holehan and Brown teaches the claimed limitations as recited in the claims. Accordingly rejections are respectfully maintained.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3-13 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holehan US Patent 6,337,918 B1 in view of Brown et al. US Patent 5,859,968 (hereinafter referred to as Brown).

5. As per claims 3 and 4, Holehan teaches a fingerprint hard disk comprising a fingerprint identifier for identifying whether the user's fingerprint is qualified [column 5, lines 15-24]; and comprising a control interface (system interface I/o controller, see figure 3, unit 42), a control signal will be issued by said control interface according to the identification result of the fingerprint identifier [column 5, lines 17-27]; hard disk comprising a hard disk body and a hard disk control device which is used to receive said control signal issued by said control interface of said fingerprint identifier to control the operation state of said hard disk body [column 5, lines 24-33 and figure 3, units 42, 48 and 50]. Furthermore Holehan teaches the system wherein said hard disk control device is a hard disk control port (hard derive controller, see figure 3, units 42, 48 and 50), and the system wherein control board is placed respectively inside each of said fingerprint identifier (figure 3, unit 46) and said hard disk (figure 3, unit 48), and a microprocessor (figure 3, unit 26), a interface circuit (figure 3, unit 43), and a RAM (figure 3, unit 30) are shared commonly by both control board (i.e., system units connected by bus and bridge,

see figure 3); and whether to enable the hard disk control procedure running by the hard disk control device is determined by the fingerprint identification procedure implemented by the fingerprint identifier on the basis of the identification result [column 5, lines 24-33]. Holehan does not explicitly teach the control interface of said fingerprint identifier and a power supply interface of said hard disk both are connected with the hard disk body through the hard disk control (electric controlled switch). However, connecting a power supply, an electronic controlled switch, hard disk and an access control interface (fingerprint identifier) is well known in the art. For example, Brown teaches a data security device for controlling access including connecting a power supply, an electronic controlled switch, hard disk and an access control interface (note that Brown suggests fingerprint access control, column 4, lines 34-37) [column 2, lines 8-23 figures 1-4]. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a system comprising control interface of a fingerprint identifier and a power supply interface of a hard disk both connected with the hard disk body through the hard disk control as per teachings of Brown into the computer system taught by Holehan in order to control access to different unit of a system such as external hard drives and allow or prevent addition or removal of information by using access controller, coupled between the power supply and other system units.

6. As per claims 5-7, Holehan teaches a fingerprint hard disk comprising a fingerprint identifier for identifying whether the user's fingerprint is qualified [column 5, lines 15-24]; and comprising a control interface (system interface I/O controller, see figure 3, unit 42), a control signal will be issued by said control interface according to the identification result of the fingerprint identifier [column 5, lines 17-27]; hard disk comprising a hard disk body and a hard disk control device which is used to receive said control signal issued by said control interface of

said fingerprint identifier to control the operation state of said hard disk body [column 5, lines 24-33 and figure 3, units 42, 48 and 50]. Furthermore Holehan teaches the system wherein said hard disk control device is a hard disk control port (hard derive controller, see figure 3, units 42, 48 and 50), and the system wherein control board is placed respectively inside each of said fingerprint identifier (figure 3, unit 46) and said hard disk (figure 3, unit 48), and a microprocessor (figure 3, unit 26), a interface circuit (figure 3, unit 43), and a RAM (figure 3, unit 30) are shared commonly by both control board (i.e., system units connected by bus and bridge, see figure 3); and whether to enable the hard disk control procedure running by the hard disk control device is determined by the fingerprint identification procedure implemented by the fingerprint identifier on the basis of the identification result [column 5, lines 24-33]. Holehan does not explicitly teach a control interface of fingerprint identifier connected to magnetic head signal wire / rotary motor control wire/ or rotation motor control wire through electric controlled switch. Brown teaches a data security device for controlling access including connecting an electronic controlled switch, hard disk and an access control interface (note that Brown suggests fingerprint access control, column 4, lines 34-37) [column 2, lines 8-23 figures 1-4]. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a system comprising connecting a control interface of the fingerprint identifier to magnetic head signal wire through an electric controlled switch as per teachings of Brown into the computer system taught by Holehan in order to control access to different unit of a system such as external hard drives and allow or prevent addition or removal of information by using access controller, coupled between the power supply and other system units.

7. As per claims 8 and 15-18 the combination of Holehan and Brown teaches the device as applied above. Furthermore, Holehan teaches the system wherein a control board is placed respectively inside each of said fingerprint identifier (figure 3, unit 46) and said hard disk (figure 3, unit 48), and a microprocessor (figure 3, unit 26), a interface circuit (figure 3, unit .43), and a RAM (figure 3, unit 30) are shared commonly by both control board (i.e., system units connected by bus and bridge, see figure 3); and whether to enable the hard disk control procedure running by the hard disk control device is determined by the fingerprint identification procedure implemented by the fingerprint identifier on the basis of the identification result, or whether to enable the operation of the hard disk will be determined by the hard disk control procedure operated by the hard disk control device on the basis of the decision result of the fingerprint identification procedure [column 5, lines 24-33].

8. As per claims 9-13, the combination of Holehan and Brown teaches the system as applied above. Furthermore, Brown teaches the system, wherein said electric controlled switch is relay or an electronic switch [column 5, lines 46-50].

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

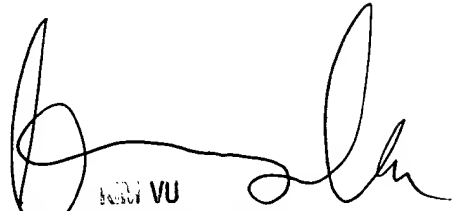
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beemnet W Dada whose telephone number is (571) 272-3847. The examiner can normally be reached on Monday - Friday (9:00 am - 5:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Beemnet Dada

February 5, 2005

  
KIM VU  
ELECTRONIC PATENT EXAMINER  
ELECTRONIC BUSINESS CENTER 21